

## REMARKS

Applicant has amended the first paragraph of the application to provide the filing date of the PCT application, along with that of the German priority application.

Applicant respectfully traverses the rejection of claims 33-42, 60, 91-99, 117, 118 and 121 which are currently pending.

Before discussing the rejections based on 35 U.S.C. § 103, it is thought proper to briefly state what is required to sustain such a rejection. The real issue under Section 103 is whether the Examiner has stated a case of prima facie obviousness.

The PTO has the burden under section 103 to establish a prima facie case of obviousness.

It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that

individual to combine the relevant teachings of the references.

In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988) (citations omitted). In establishing a prima facie case of obviousness, the PTO "cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."

Id. at 1600. While Applicant admits that virtually every element of a claim may be found somewhere in the prior art, this is not the test to determine whether the prior art renders the invention obvious. Rather, "[t]he test is whether the claimed invention as a whole, in light of all the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made." Connell v. Sears, Roebuck & Co., 220 U.S.P.Q. 193, 199 (Fed. Cir. 1983).

As will be discussed in additional detail below, Applicant believes that the Examiner has failed to make a prima facie case of obviousness in that he has failed to show either (a) some objective teaching in the prior art that suggests combining the references, or (b) knowledge generally available to one of ordinary skill in the art which would lead that individual to combine the relevant teachings of the references to achieve the invention claimed. See In re Fine, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

When making a rejection under 35 U.S.C. § 103 there are three fundamental areas the Examiner is required to cover under 37 CFR § 1.106 and MPEP § 706.02. First, the rejection should set forth the differences between the claims and the prior art. Second, the proposed modification of the applied references necessary to arrive at the claimed subject matter should be set out. Third, there must be an explanation as to why such proposed modifications would be obvious.

Furthermore, the Court of Appeals for the Federal Circuit has warned against the over-reliance on 'skill in the art.' The level of skill in the art is a prism or lense through which a judge or jury views the prior art and the claimed invention. This reference point prevents these decides from using their own insight or, worse yet, hindsight, to gauge obviousness. Rarely, however, will the skill in the art component operate to supply missing knowledge or prior art to reach an obviousness judgment. See *W.L.Gore & Assocs., Inc. v. Garlock, Inc.* 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 312-13 (Fed. Cir. 1993)("To imbue on of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teaches.") Skill in the art does not act as a

bridge over gaps in substantive presentation of an obviousness case, but instead supplies the primary guarantee of objectivity in the process." *Al-Site Corp. v. VSI International, Inc.*, 50 U.S.P.Q.2d 1161, 1171 (Fed. Cir. 1999). In the present case, it is apparent that attempts to combine the prior art have been made without keeping in mind the real world contexts of the various pieces of prior art.

In the present case, the Examiner relies exclusively on "skill in the art" to justify the combination of Kelly and Otto to reject claims 33, 38-40 and 60. Applicant respectfully traverses the rejection. Not only does the office action fail to specifically explain why one of ordinary skill in the art would selectively combine the references, as has been done by the Examiner, Applicant submits that the references actually teach one of skill in the art away from the invention.

First, with respect to Otto, the reference teaches a separate drive element (13 FIG. 1) in combination with the rotor. The drive element has a coupling section which is received in a slot in the rotor. Therefore, Otto does not teach a rotor formed from one piece of plastic. This alone is enough for the rejection to fall. Simply replacing the rotor of Kelly with the rotor of Otto would not provide the claimed invention. Thus, with no teachings from the references, the Examiner selectively picks and chooses from references those elements which support the claims, without any consideration for the teachings in both references away from the claims. Specifically, Otto teaches away from a one-piece plastic rotor.

Kelly, however, is also inconsistent with the combination suggested by the Examiner, but not supported by either reference. Specifically, Kelly teaches a **high compression rotary motor**. Applicant respectfully submits that one of ordinary skill in the art would not substitute

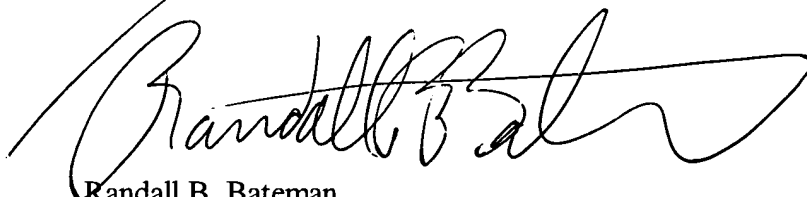
the rotor of Kelly with the rotor of Otto, let alone form an altogether new one-piece plastic rotor. One of ordinary skill in the art would look at the real world use of Kelly - a high compression rotary motor, and look to something other than a one-piece plastic rotor. Thus, Applicant's respectfully submit that the rejection is a violation of the hind-sight reconstruction prohibited by In re Fine, and submit that all of these claims are in condition for allowance.

Applicant further object to the combination of Kelly, Otto and Hattori et al. as set forth to reject the remaining claims. As with the prior rejection, there is nothing in the prior art which suggests the combination of the three different references. Likewise, there is no knowledge generally available in the art which suggests the combination. Rather, the Examiner is forced to rely on skill in the art and to selectively pick and chose from the inventions to create a combination which would fall within the scope of the claims. This blatant hind-sight reconstruction has been strictly prohibited by the Court of Appeals for the Federal Circuit. Furthermore, nothing in the art cited by the Examiner or knowledge generally known to those skilled in the art would suggest using a one-piece plastic rotor (not taught in any of the references) in a high compression rotary engine (Kelly) with a cavity opening at the edge of the rotor (Hattori). At the time of Applicant's invention, one of ordinary skill in the art would likely have viewed the combination suggested by the Examiner to be a recipe for how to create a catastrophic engine failure. Reducing the weight of a rotor may appear a desired goal, but attempting to do so in a high compression rotary engine by the use of a plastic, one-piece rotor with cavities formed therein would not have been obvious to one of ordinary skill in the art. To the contrary, the drawbacks of such a combination would have been obvious. Thus, one of ordinary skill in the art would not have made the selective combination raised by the Examiner.

It is believed that the application is in condition for allowance. Should the Examiner determine that adverse action is necessary, it is requested that he contact Applicant's attorney, Randall B. Bateman, at (801) 478-0071 so that such matters may be resolved as expeditiously as possible. The Commissioner is hereby authorized to charge any amounts owing or to credit any overpayment to Account No. 50-0881.

Respectfully Submitted,

MORRIS, BATEMAN, O'BRYANT & COMPAGNI, PC

A handwritten signature in black ink, appearing to read "Randall B. Bateman", written over a horizontal line.

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filed September 30, 1998.